



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,852	01/15/2002	Hiroshi Matoba	15210	5935
23389 7590 11/16/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER TEKLE, DANIEL T	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/046,852	Applicant(s) MATOBA ET AL.	
	Examiner Daniel Tekle	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The office action mailed on June 04, 2007 has been withdrawn because restriction is required due to separate invention of the independent claims.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 22-31 and 38 drawn to a method of selecting a program which meets a user's test from broadcast programs and recording the selected program in an automatic broadcast recording apparatus in a system having a server and the automatic broad cast recording apparatus with "time recording pattern information".
- II. Claim 10-12, 16-18, 35-37 and 42-47 drawn to a method of accumulating a program which meets a user's test from broadcast programs and recording the selected program in an automatic broadcast recording apparatus in a system having a server and the automatic broad cast recording apparatus with "sending playback information, collecting sent information, calculating a taste level and deleting recorded program with lower test level".
- III. Claims 13-15 and 19-21 drawn to accumulating a program which meets a user's test from broadcast programs in a system having a server and automatic broadcast recording apparatus comprising comparing: "a predetermined taste level new program with program recorded in past, deleting the program whose taste level is lower than new program and recording new program, if the is no lower taste level stop recording".

- IV Claims 39-41 and 48 drawn to a computer readable medium having computer readable program code for executing on a computer to perform "a process of providing a user with information to select a broadcast program which meets the user's taste through a web-page".

The inventions are distinct, each from the other because of the following reasons:

**Invention I and II** is distinct each from the other. Invention I is a method of selecting a program with a "time recording pattern information" while invention II is a method of accumulating program with sending playback information, collecting sent information, calculating a taste level and deleting recorded program with lower test level. The inventions are independent and distinct one to another.

**Invention I and III** is distinct each from the other. Invention I is a method of selecting a program with a "time recording pattern information" while invention III a method of accumulating data comparing: a predetermined taste level new program with program recorded in past, deleting the program whose taste level is lower than new program and recording new program, if the is no lower taste level stop recording. The inventions are independent and distinct one to another.

**Invention I and IV** is distinct each from the other. Invention I is a method of selecting a program with a "time recording pattern information" while invention IV a computer readable medium having computer readable program code for executing on a computer to perform a process of providing a user with information to select a broadcast program which meets the user's taste through a web-page. The inventions are independent and distinct one to another.

**Inventions II and III** is related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

Invention II does not require the feature of "a predetermined taste level new program with program recorded in past, deleting the program whose taste level is lower than new program and recording new program, if the is no lower taste level stop recording" as claimed in invention III. Similarly invention III does not require the feature of "sending playback information, collecting sent information, calculating a taste level and deleting recorded program with lower test level" as claimed in invention II. The inventions are independent and distinct one to another.

**Invention IV and II-III** is distinct each from other. Invention IV drawn to "a computer readable medium having computer readable program code for executing on a computer to perform a process of providing a user with information to select a broadcast program which meets the user's taste thought a web-page"; While invention II is drawn to "a method of accumulating program with sending playback information, collecting sent information, calculating a taste level and deleting recorded program with lower test level", and Invention III is drawn to "a method of accumulating data comparing: a predetermined taste level new program with program recorded in past, deleting the program whose taste level is lower than new program and recording new program, if the

is no lower taste level stop recording". The inventions are independent and distinct one to another.

Therefore because these invention are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their differences, restriction for examination purpose as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traverse (37 CFR 1. 143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Tekle whose telephone number is 571-270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other F..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/046,852  
Art Unit: 2621

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel Tekle

*Marsha D Banks-Harold*  
MARSHA D. BANKS-HAROLD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600